UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte DAVE B. LUNDAHL

Appeal No. 2005-1798
Application No. 09/326,405

ON BRIEF

Before KIMLIN, GARRIS and WARREN, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

REMAND TO THE EXAMINER

This is an appeal from the final rejection of claims 11-33. Claims 11-13, 15-18, 20-23, 25-28 and 30-33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kehne in view Lazarek. Claims 14, 19, 24 and 29 also stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the stated combination of references further in view of Jones.

In support of appellant's rebuttal of the examiner's rejections the following is submitted at page 9 of the Brief:

> The Board's attention is directed to the 35 CFR 1.132 declarations of Mr. Randy Helzer (Appendix B) and Mr. Michael Thompson (Appendix C), which describe advantages of the claimed invention and tie these advantages to actual sales made by a licensee of the invention, i.e., Point Five Windows. Point Five Windows has been a licensee of the present technology since 1998, when the parent provisional application of the present patent application was filed.
>
> Mr. Helzer is Vice President for Marketing and Sales at Point Five Windows. Mr. Helzer states that the Frameless Velcro Screen System as sold by Point Five Windows includes all of the limitations of the amended claims as set forth in Amendment D, which are the claims presented in the Appeal.

Appellant concludes at page 10 of the Brief that "[t]hese affidavits clearly establish that, at least, specific sales were made which were due in part to the Frameless Velcro Screen System, that includes all the limitations of the independent claims in this appeal" (last paragraph). Hence, appellant relies upon affidavit evidence of commercial success in order to rebut the examiner's § 103 rejections.

We have reviewed the Examiner's Answer in vain for a discussion of appellant's affidavit evidence and argument for commercial success of the claimed invention. While the examiner responds to most of appellant's arguments, a response to the argument based upon commercial success is conspicuously absent.

Accordingly, this application is remanded to the examiner for the purpose of affording the examiner the opportunity to

submit a Supplemental Examiner's Answer that addresses appellant's argument for commercial success. Also, should the examiner submit a Supplemental Examiner's Answer, appellant has the right to answer via a Reply Brief.

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

REMAND

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Administrative Patent Judge)
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